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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,366

02/11/2005

Jurgen Meyer

032301.411

9856

25461 7590 10/30/2008
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EXAMINER

HAILEY, PATRICIA L

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

10/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,366

Applicant(s)

MEYER ET AL.

Examiner

PATRICIA L. HAILEY

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7, 11, 12 and 14-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 6, 7, 17 and 18 is/are rejected.
7) ☒ Claim(s) 4, 5, 11, 12, 14-16, 19, and 20 are is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Applicants' remarks, filed on July 7, 2008, have been carefully considered. No claims have been canceled or added; claims 1, 4-7, 11, 12, and 14-20 remain pending in this application.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on February 11, 2005.

Withdrawn Rejections

The 103(a) rejection of claims 1, 4-7, 11, 12, and 14-20 as being unpatentable over Deller et al. (U. S. Patent No. 5,776,240) or Ettlinger et al. (U. S. Patent No. 5,665,156) taken with Nargiello et al. (U. S. Patent No. 6,193,795), stated in the previous Office Action, has been withdrawn in view of Applicants' persuasive arguments traversing this rejection.

Declaration under 37 CFR 1.132

The Declaration under 37 CFR 1.132 filed July 7, 2008, is sufficient to overcome the rejection of claims 1, 4-7, 11, 12, and 14-20 based upon Deller et al. (U. S. Patent No. 5,776,240) or Ettlinger et al. (U. S. Patent No. 5,665,156) taken with Nargiello et al. (U. S. Patent No. 6,193,795).

Maintained Rejection

2. *Claims 1, 6, 7, 17, and 18 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 8, 9, and 14-16 of copending Application No. 10/522,903.*

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are drawn to silanised, structurally modified pyrogenically produced silicas characterized by octylsilyl and/or hexadecylsilyl groups fixed to their surface (**claim 1**), and to lacquer compositions comprising said silicas (**claims 6, 7, 17 and 18**).

The claims in the copending application are drawn to a lacquer composition comprising silanized, structurally modified pyrogenic silica, wherein said silica can have attached to the surface thereof an alkylsilyl group according to the molecular formula $\text{SiC}_n\text{H}_{2n+1}$, wherein "n" is from 2 to 18 (**claims 2, 8, and 9**), and to said silanized, structurally modified pyrogenic silica itself (**claims 14-16**).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicants have deferred this rejection "until resolution of the patentability issue in this case." This rejection has been maintained because Applicants have neither traversed the rejection nor filed a Terminal Disclaimer.

Allowable Subject Matter

3. Claims 4, 5, 11, 12, 14-16, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. HAILEY whose telephone number is (571)272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PATRICIA L. HAILEY/
Primary Examiner, Art Unit 1793
October 27, 2008